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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,134	12/29/2000	Gary L. Shanklin	659/766	1798
757	7590	07/01/2004	EXAMINER	
BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610			SALVATORE, LYNDA	
			ART UNIT	PAPER NUMBER

1771

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/753,134

Applicant(s)

SHANKLIN, GARY L.

Examiner

Lynda M Salvatore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6, 10-20, 22 and 35-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-6, 10-20, 22 and 35-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

**DETAILED ACTION*****Response to Amendment***

1. Applicant's remarks filed 04/08/04 have been fully considered and entered. Applicant's arguments regarding the rejection of claims 1-3 5,6, 10-20,22 and 35-47 rejected under 35 U.S.C. 103(a) as being unpatentable over Rothe et al., US 4,738,847 in view of Goulet et al., US 6,054,020 are found persuasive. According to Applicant's declaration filed 11/24/03 the claimed invention was completed prior to July 29<sup>th</sup>, 1999 which is earlier than the issue date of April 25<sup>th</sup>, 200 of Goulet et al., and was commonly owned by Kimberly-Clark Worldwide, Inc. at the time the invention of the present application was made. As such, Applicant's invoke 35 U.S.C 103 (c). Specifically, under 35 U.S.C. 103 (c) Goulet et al., cannot be used, alone or in combination with other references. Thus, the obviousness type rejections set forth in sections 3 and 4 of the last Office Action are hereby withdrawn. However, upon further consideration a new ground of rejection is set forth herein below.

***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-3 5,6, 10-20,22 and 35-47 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 10-12 of U.S. Patent No. 6,054,020 (Goulet et al., ) in view of Rothe et al., US 4,738,847.

The patent issued to Goulet et al., claims applying an amine-modified polysiloxane to the outer surfaces of a two or three ply tissue product. The general formula of the amine-modified polysiloxane is that of the Applicant's structure shown in instant claim 1. Goulet et al., fails to teach applying a virucidal composition to the inner layer of the product, however, the patent issued to Rothe et al., discloses a multi-ply absorbent article comprising a virucidal composition confined to the inner layer of the product (Abstract). Preferably the absorbent article comprises three plies, wherein the inner or middle layer further comprises a virucidally effective amount of a virucidal composition (Column 1, lines 22-35). Rothe et al., teaches applying the virucidal composition to the inner ply layer to reduce any irritation that may result from having the virucidal composition present on the surface of the article (Column 2, lines 10-20). The plies may be made from webs of cellulosic creped wadding, however, non-woven webs synthetic polymeric fibers are also suitable (Column 2, lines 47-54). The three-ply absorbent article is suitable for use as facial tissues, bathroom tissues, paper towels or wipes (Column 1, lines 36-39). Suitable virucidal compositions include acids having the formula  $R-COOH$ , wherein R is selected from the group of lower alkyl; substituted lower alkyl; carboxy lower alkyl or carboxy dihydroxy (Column 1, lines 40-60).

Therefore, motivated by the desire to provide an anti-microbial tissue product it would have been obvious to having ordinary skill in the art at the time the invention was

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made to apply the virucidal composition taught by Rothe et al., to the amine-modified polysiloxane multi-ply tissue product claimed by Goulet et al.

4. Claim 4 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 10-12 of U.S. Patent No. 6,054,020 (Goulet et al.,) in view of Rothe et al., US 4,738,847 as applied to claim 2 above and further in view of Roe et al., US 5,635,191.

The combination of prior art of Goulet et al., and Rothe et al., and fail to teach a liquid-impermeable base ply, however, the patent issued to Roe et al., discloses a disposable diaper comprising a liquid pervious top sheet having a fluid polysiloxane emollient/ lotion applied to the surface thereof (Abstract). The diaper construction generally includes the polysiloxane containing top sheet, an absorbent core, and a liquid impervious back sheet (Column 4, lines 18-24). Roe et al., discloses that the absorbent capacity of the core may be tailored suit a variety personal care needs such as diapers, sanitary napkins and incontinence pads (Column 5, lines 1-5).

Therefore, motivated by the desire to produce a virucidal disposable absorbent article it would have been obvious to one having ordinary skill in the art to provide the multi-ply article of Rothe et al., and Goulet et al., with a liquid-impermeable base ply as taught by Roe et al.

### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda M Salvatore whose telephone number is 571-272-1482. The examiner can normally be reached on M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1482. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 15, 2004

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